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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

MAILED

MAR 05 2003

GROUP 3600

Application Number: 09/710962

Filing Date: November 10, 2000

Appellant(s): Severinsson

ST. Onge Steward Jonston & Reens

For Appellant

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EXAMINER ' S ANSWER

This is in response to the appeal brief filed February 11, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. Please refer to the discussion in the office action of paper number 9.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The Board is directed to the appellant's remarks made in their response (paper #5) in the original application 08/817769 at the bottom of page 6 over to page 7 and the examiner's subsequent amendment made to claim 1 line 3 to place the case

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into condition for allowance. Also see column 2 line 29 of the 5,833,035 specification and the language in the patent claim.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 19-22 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims and have been maintained from the final rejection in paper number 12:

Claim Rejections - 35 U.S.C. 251

Claim 19 (25) remains rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of

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35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Regarding claim 19 note applicants omit claiming the cover as a part of a self sustained unit in a braking mechanism.

In the parent case 08/817769 the limitation of the cover was claimed in combination with the housing see patent claim 1 line 3 (note the examiner made an amendment to this claim to overcome 112 second paragraph combination-subcombination problems at that time). Note also in the patent claim beginning with line 5 applicant claims structure, namely "two thrust sleeves (8)... *arranged on the cover* for disposal in the housing..."

In the specification of the patent 5,833,035 column 2 note line 29 "...but the cover and the rest of the mechanism are also *held together as a unit*..."

At page 6 over to page 7 of applicants remarks in the original application 08/817769 applicants stated "Parent claim 1 is amended to better structurally define applicants novel feature wherein the housing and cover members are structured with the *entire braking unit carried by the cover* independently from the housing to be inserted as a unit".

Note also applicants remarks in paper no. 5 filed in the first reissue application 09/324506. At page 4 line 13 applicants state "the "mechanism as a unit" is clearly disclosed, wherein the cover and the rest of the mechanism is held together in the absence of the housing 1". At page 5 line 10 in the same amendment applicants state "However, applicant provides a unitary assembly that is assembled outside the housing and thus is inserted as a unit into the housing". Presumably this "unit" must include the cover. These latter remarks were directed at distinguishing applicants invention from the Antony et al. reference.

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From these arguments it remains unclear then how the cover can be left out of the picture if the inner workings of the brake mechanism are attached to it for insertion into the housing "as a unit". It therefore remains the examiner's position that the invention, as originally claimed, is the combination of the housing and the cover and the inner workings of the brake mechanism.

One of the errors in the declaration submitted in the parent reissue states "... that no independent claim is broadly directed to the concept that the two thrust sleeves, cross bar and lever are preassembled as a unit prior to installation in the caliper"... Upon further consideration this supposed error is somewhat confusing because the first set of independent claims (13 and 21) filed with the parent reissue case both had the cover limitation in them. The "error" in the declaration hinted nothing about the omission of the cover as the basis for the reissue. Note also that nowhere in the specification does it state these specific elements (bearing tappets and thrust sleeves) are preassembled without the cover.

(11) Response to Argument

As discussed on page 5 in the response filed 6/18/02 applicant's argue "the cover does not relate to surrendered subject matter, as the cover itself was not added and no arguments about the presence of the cover itself were made in an effort to overcome a prior art rejection." Further it is argued that there was no argument made that the cover itself was required for novelty and that the examiner has already indicated that the cover is not required for novelty by specifically indicating the claims are patentable over the prior art of record.

The examiner maintains that applicants presented **arguments** in the original ('769) application the cover was a necessary limitation for novelty. At page 6 over to page 7 of applicants remarks in the original application 08/817769 applicants stated "Parent claim 1 is amended to better structurally define applicants

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novel feature wherein the housing and cover members are structured with the *entire braking unit carried by the cover* independently from the housing to be inserted as a unit”.

Note also applicants remarks in paper no. 5 filed in the first reissue application 09/324506. At page 4 line 13 applicants state “the “mechanism as a unit” is clearly disclosed, wherein the cover and the rest of the mechanism is held together in the absence of the housing 1”.

The surrender of claimed subject matter can occur by argument alone. *See Hester Industries, Inc. V. Stein, Inc. 142 F.3d 1472 (Fed. Cir. 1998)*. Further, the issue of patentability (novelty) and the issue of recapture are independent. Just because the claims have been indicated to be patentable over the prior art of record does not mean the recapture rule no longer applies.

For the reasons above it is believed the rejection above should be maintained.

Respectfully submitted,


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